

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Nathanael F. Ehrich, et al.

Serial No.: 10/674,769

Filed: September 30, 2003

For: Providing Scalable, Alternative Component-Level Views

Art Unit: 2178

Examiner: Thu V. Huynh

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Final Rejection in the Office Action mailed April 20, 2006 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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GROUND OF REJECTION PRESENTED FOR REVIEW

The **First Ground of Rejection** presented for review is a rejection of Claims 1 - 4, 7 - 12, and 18 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,457,030 to Adams et al. (hereinafter, “Adams”) in view of U. S. Patent Application 2002/0122054 to Hind et al. (hereinafter, “Hind”), according to the Office Action mailed April 20, 2006 (hereinafter, “the Office Action”).

The **Second Ground of Rejection** presented for review is a rejection of Claims 13 - 14, 16 - 17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Adams in view of Hind and further in view of U. S. Patent 6,966,034 to Narin, according to the Office Action.

ARGUMENT

For expediency only, for the **First Ground of Rejection**, Applicants will discuss independent Claims 1 and 18 with regard to Claim 1, and for the **Second Ground of Rejection**, will discuss independent Claims 13 and 19 with regard to Claim 13. Applicants reserve the right to argue additional grounds, and in particular to explicitly argue separate patentability of the dependent claims, if this Petition is denied.

With regard to the **First Ground of Rejection**, Applicants respectfully submit that a combination of Adams and Hind fails to teach or suggest all of the recitations of Claim 1. Claim 1 recites (emphasis added):

A computer-implemented method of selecting component-level views, comprising steps of:
receiving, at a server-side device, a request for content;
locating a content file comprising a template for the requested content,
wherein the template specifies a plurality of alternative selectable views of a

component that forms a portion of the content and conditions under which each of the views should be selected;
evaluating one or more factors to determine an evaluation result, wherein the factors are determined from the specified conditions;
using the determined evaluation result to select a particular one of the specified alternative selectable views; and
using the particular one of the specified alternative views, within the content file, for the portion of the content.

Applicants find no teaching in Adams or Hind of (at least) the above-underlined recitations, and will demonstrate that the teachings thereof cannot be combined to render this claim language obvious and furthermore, that the supposed motivation to combine the references, according to the Office Action, is improper.

In Applicants' independent Claim 1, the claim language specifies that the template is contained within the located content file ("locating a content file comprising a template"; Claim 1, line 4, emphasis added), and that this template "specifies a plurality of alternative selectable views of a component ..." (Claim 1, lines 4 - 5, emphasis added). The Office Action admits that Adams does not teach that the template is within the content source. Office Action, p. 4, line 16. **Figs. 3 and 7** and paragraphs **[0073]** and **[0074]** of Hind are then cited for this teaching, referring to Hind's transformation flow container ("TFC"), stating "Hind teaches a transformation file (... TFC) for transforming a content source is within a content source (in-line) or referred from a content source using a reference link" (Office Action, p. 4, lines 17 - 19). Applicants respectfully disagree with this analysis of Hind.

Hind depicts executable transformations that are specified within a file, whether those transformations are explicitly specified therein (as shown at **330, 350** of **Fig. 3**) or referenced therefrom (as shown at **720** of **Fig. 7**). However, in neither case do these transformations specify

“a plurality of alternative selectable views of a component ... and conditions ...”, in contrast to the language in Applicants’ Claim 1, lines 4 - 6 (emphasis added). In the example shown at **330** of **Fig. 3**, the transformation syntax identifies an invocable method and parameter information therefor (Hind, para. [0054] - [0058]); the transformation syntax shown at **350** of **Fig. 3** identifies a family of invocable style sheets from which a selection can be made at run-time to “style”, or format, the output of the invocable method (Hind, para. [0062]).

In both approaches illustrated in Hind’s **Figs. 3** (as well as in **Fig. 7**), there is still (at least) one additional file involved. In the first transformation **330** of the so-called “in-line” approach cited in the Office Action, a first additional file comprises an externally-stored JavaBean having a name of “class.test” (see **334** of **Fig. 3**), and in the second transformation **350** of this “in-line” approach, a second additional file comprises the to-be-selected (externally-stored) style sheet for which a family name is provided at **353**. In the “reference-type” approach illustrated by **Fig. 7**, an additional file comprises an externally-stored TFC identified at **720** (which in turn would contain further invocations of externally-stored JavaBeans or references thereto).

Combining the cited references therefore fails to yield Applicants’ claimed invention, where a content file “compris[es] a template for the requested content, [and] wherein the template specifies [also within the content file] a plurality of alternative selectable views of a component” (Claim 1, lines 4 - 6). Furthermore, because the combination fails to teach the template within the file, the cited references also do not teach “using the particular one of the specified alternative views, within the content file [from which it was selected], for the portion of the content” (Claim 1, lines 11 - 12, emphasis added).

Furthermore, the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP §2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed Cir. 1990)). The Court of Appeals for the Federal Circuit has further stated, in *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), that to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. The supposed motivation provided in the Office Action is stated on p. 4, line 20 - p. 5, line 2, stating “... the combination would have provided many implementations as Hind disclosed”. Applicants respectfully submit that this supposed motivation is not clear and particular, and provides only broad and conclusory statements about Hind’s teachings, in violation of the holding in *In re Dembiczak*. Furthermore, Applicants are unable to determine what is meant by “provided many implementations”, since they find no occurrence in Hind of the phrase “many implementations”.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been made out with regard to their independent Claim 1, or to independent Claim 18, which specifies similar limitations. These claims are therefore deemed patentable over the references. Applicants’ dependent Claims 2 - 4 and 7 - 12 (as well as dependent Claim 5) are thereby deemed patentable by virtue of (at least) the allowability of the independent claims from which they depend.

With regard to the **Second Ground of Rejection**, Applicants respectfully submit that a

combination of Adams, Hind, and Narin fails to teach or suggest all of the recitations of Claim 13.

Claim 13 recites (emphasis added):

A computer-implemented method of generating content using alternative component-level views, comprising steps of:
determining, at a server-side device, that content should be generated from a particular template, wherein the template is contained within a content file for the content and specifies a plurality of alternative selectable views of a component that forms a portion of the content, conditions under which each of the views should be selected, and an associated selection identifier for each of the specified alternative selectable views;
evaluating one or more factors to determine an evaluation result, wherein the factors are determined from the specified conditions;
mapping the determined evaluation result to a particular one of the specified selection identifiers, thereby selecting the associated one of the specified alternative selectable views; and
using, when generating a version of the content, the selected alternative view of the component.

Applicants find no teaching in Adams, Hind, or Narin of (at least) the above-underlined recitations. In fact, the Office Action admits (p. 13, line 1) that Adams does not disclose that “the template is within the content source”. Hind is then cited (p. 13, lines 3 - 5) for this teaching. As demonstrated above with regard to the **First Ground of Rejection**, Hind also does not provide this teaching, and the motivation for combining Hind with Adams (Office Action, p. 13, lines 6 - 9) is improper. Such teaching is also not found in Narin, and thus a combination of these references fails to teach all limitations of Applicants’ independent Claim 13.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been made out with regard to their independent Claim 13, or to independent Claim 19, which specifies similar limitations. These claims are therefore deemed patentable over the references. Applicants’ dependent Claims 14 and 16 - 17 (as well as dependent Claim 15) are thereby deemed patentable by virtue of (at least) the allowability of the independent claims from which they depend.